been added by the present amendment. The changes to Claims 35 and 36 and the addition of Claims 45 and 46 are supported by the originally filed specification. Specifically, the changes and additions are supported by Figures 7 and 8 and their description between page 29, line 10, and page 33, line 11, of the specification. Accordingly, no new matter has been added.

In the outstanding Office Action, Claims 14-17 and 31-34 were rejected under 35 U.S.C. § 103(a) as unpatentable over Hanson et al. (US 5,974,398) in view of DeLapa et al. (US 6,076,068); Claims 35-37 were rejected under 35 U.S.C. § 103(a) as unpatentable over Mendler ("Competition drives operators toward retail innovation"; Claims 1, 4, 5, 9, 11, 12, 18, 21, 22, 26, 28-30, 38 and 41-44 were rejected under 35 U.S.C. § 103(a) as unpatentable over Buhrmann et al. (US 5,933,778) in view of Civanlar (EP 0 732 835 A 2); Claims 2, 3, 6-8, 10, 19, 20, 23-25, 27, 39 and 40 were rejected under 35 U.S.C. § 103(a) as unpatentable over Buhrmann et al. in view of Civanlar, and further in view of Hanson et al.

Applicants acknowledge with appreciation the courtesy of the interview granted to Applicants' attorney on November 6, 2002, at which time the outstanding issues in this case were discussed. During the interview, no exhibits were shown and no demonstrations were conducted. Additionally, the Examiner's interpretation of the claims was discussed as it relates to where each step in the pending claims is performed. In order to ensure that the claimed steps were interpreted as being performed by the server, it was discussed that changes similar to the changes made herein would accompany a next response. No agreement was reached as to the allowability of the claims.

In response to the rejection of claims other than claims 35-37, it is respectfully submitted that such grounds for rejection are rendered moot by the cancellation of those claims. Applicants expressly reserve the right to reinstitute those claims later, or in a divisional or continuation application.

In response to the remaining rejections under 35 USC 103 in light of Mendler, those rejections are respectfully traversed for not providing proper support for the proposed combination for the reasons set forth below. During the interview, the basis for the outstanding rejection of the pending claims was discussed. Applicant's representative believes that the examiner confirmed that while MCI may have had a "Friends and Family" promotion, that promotion did not include the establishment of a conference call with an existing MCI customer and his/her friends or family. Moreover, any such motivation to do so

is not found in the references of record or in anything identified as knowledge within the art at the time of filing.

The Office Action alleges that "It would have been obvious to a person of ordinary skill in the art ... to have included delivering a conference marketing message to the friends and family of the customer because such a modification would save time by enabling the MCI operators to deliver the same message to the parties at the same time." Office Action, page 4, last line, to page 5, line 4. It is respectfully submitted that such a motivation is not found in either the reference or the evidence of what occurred under the Friends and Family promotion. Since an existing MCI customer has already subscribed to MCI and apparently the point of MCI calling the friends and family members later is to sign up new customers, it is clear that the MCI operator would not subject the <u>existing</u> MCI customer to a pitch to sign up – the customer has already signed up. Thus, it is not clear how providing such a sales pitch to an existing customer saves any time, as alleged. Moreover, if the Office Action intends to say that both parties are delivered some <u>other</u> marketing message, it is respectfully submitted that no evidence in support thereof is of record.

Moreover, the reference itself describes why the "Friends and Family" data was collected, and it has nothing to do with joint marketing calls. The article states that "it reduces costs ... [because] MCI can calculate predictable routes for calls and balance loads." Thus, the motivation alleged by the Office Action is not found within the cited reference.

The motivation is also not found within the knowledge of those skilled in the art. During the interview, Examiner Alvarez pointed out that if the existing customer remained on the line while the friend or family member was contacted, the friend or family member may feel pressured into joining so as to not disappoint the customer – essentially strong-arming the friend or family member into joining. As discussed during the interview, there is admittedly no evidence of record that shows that such a conference call was ever made between an existing customer and a friend or family member. In March 1996, when the article was written, MCI had 6,500 marketing and sales employees. See Exhibit 1, page 32 of 225, showing MCI's SEC 10-K statement dated March 30, 1999. If 6,500 employees did not see an advantage to modifying the Friends and Family promotion to include a teleconference between existing customers and their friends or family members, then it is respectfully submitted that the motivation for such a change is not "obvious."

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Moreover, the Office Action has not even identified any teaching showing that one of ordinary skill in the art understood that there was a problem in the Friends and Family promotion such that he/she would have been motivated to modify the promotion as alleged. In addition, if there was a recognition of a need to improve the promotion, then apparently the cadre of MCI employees have not been able to solve that problem in 6 years since there is no evidence that the problem has been solved to date by anyone except the applicants. Such a "long felt need" is also indicative of non-obviousness.

In addition, as admitted by the Office Action, AT&T lost market share to MCI but did not develop the alleged obvious modification to MCI's Friends and Family promotion. If AT&T were losing market share to such a promotion, clearly they would have introduced a better, competing promotion if it had been "obvious" how to improve upon it. AT&T did not introduce such a promotion because such a method's creation was not obvious at all. The only tenable motivation for the proposed modification is based solely on the present application, and it is impermissible to use the Applicants' specification against them.

As a final note, the Office Action alleges that it is "well known to place conference calls that deliver marketing messages" and cites an example of how a mortgage company allegedly would use a conference call. It appears that the Office Action is relying on either (1) facts within the personal knowledge of the examiner or (2) is taking Official Notice that conference calls have been used in such a manner.[1] If the Office Action is relying on (1), it is respectfully requested that an affidavit be provided in the next Office Action in compliance with MPEP 2144.03 so that the record may accurately reflect what facts are alleged to have been known at the time of Applicants' filing. Similarly, as for (2), as provided for under MPEP 2144.03, if the Office Action is intending to rely on Official Notice, this response shall serve as Applicants official traversal of such notice. MPEP 2144.03 is therefore applicable and states "If the applicant traverses such an assertion [of Official Notice] the examiner should cite a reference in support of his or her position."
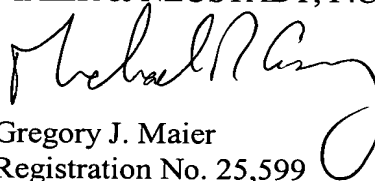
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[1] Alternatively, it is possible that the Office Action is speculating what could have been done but which has not actually been done. If the rejection is based on such a speculation, it is respectfully submitted that speculation is not a recognized ground for rejection under 35 USC 102 or 103.

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Accordingly, in view of the foregoing, claims 35 and 36, which both recite establishing a conference call by a server and delivering, by a server, a marketing message during the conference call, are neither anticipated by nor rendered obvious by the proposed combination/modification of the cited references. Their respective dependent claims are patentable for at least the reasons set forth for the patentability of claims 35 and 36 above. Thus, the present application is believed to be in condition for formal allowance. An early and favorable action is hereby respectfully requested.

Respectfully submitted,

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IN THE CLAIMS

Please amend Claims 35 and 36 as follows:

35. (Amended) A method for a communications server to deliver a marketing message, said method comprising the steps of:

receiving a telephone call from a caller at said server;

querying said caller by said server for a third-party telephone number;

receiving said third-party telephone number at said server;

establishing, by said server, [initiating] a telephone conference call between said caller and a third-party at said third-party telephone number;

delivering from said server to said caller and said third-party a marketing message during said telephone conference call.

36. (Amended) A method for a communications server to deliver a marketing message, said method comprising the steps of:

receiving a telephone call at said server, from a caller having a calling card, said calling card having a predetermined number of minute credits associated with it;

receiving a calling card number of the caller at the server;

querying, by said server, said caller for a third-party telephone number;

receiving at said server said third-party telephone number;

establishing, by said server, [initiating] a telephone call between said caller and a

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third-party at said third-party telephone number;

delivering to said caller and said third-party a marketing message during said initiated telephone call.

45-46. (New)